

Putting the world at your fingertips with
priority rights



Contents

Putting the world at your fingertips with priority rights	3
Priority right gives international priority	4
Industrially applicable, novel and inventive	5
Extending the effective patent term	5
Additions to an application can be risky	6
How to structure a patent application	6
Patent lost due to changes in application	7
The relevance of genus and species	8
Even genuine mistakes are difficult to rectify	9
A grace period is the exception	10
Trademarks have priority right for six months	11
The chances of obtaining a patent	11
European grace period for designs	12
Pay careful attention to dates on internet publications	12
Registration at civil-law notary does not offer protection at a later stage	13
Double protection requires coordination	13
Protection is a balancing act	14

This publication has been produced by EP&C, specialists in global patent and design protection. EP&C is a contemporary patent agency that was founded in 1939. It has a rich history in protecting Intellectual Property and has seventy employees operating from branches in the Netherlands and Belgium. EP&C's team of attorneys combines legal expertise and technical specialisms with in-depth knowledge of specific market sectors and industries.

Putting the world at your fingertips with priority rights

A patent is generally the best instrument for protecting a technical invention, yet it is not something that happens by itself. Drafting a patent application and filing it in the countries that are relevant to your business, involves choices and considerable investment: choices that can be made only once.

One important step is filing the initial patent application. Generally speaking, the most obvious place to do this, is in the country where your business is established, e.g. in the Netherlands. However, the application will subsequently need to be filed in other countries before you can take your business to those parts of the world.

International protection

Industrialised countries were already aware of the importance of filing a patent application abroad as long ago as the nineteenth century. In fact, the phenomenon of priority rights dates from then. The right of priority is automatically created when an initial patent application has been filed. You then have the (priority) right to file additional applications during the subsequent twelve months, from the date of filing that very first initial application.

At the end of the first year, many people opt for a PCT application. This PCT application gives you an additional eighteen months to decide in which countries you wish to file your patent applications, and to explore international markets, look for business partners and so on.

Priority rights were created in the days when applications had to be transported by steamer and stage coach, etc. Yet even now the stage coach trails of the nineteenth century have made way for the digital highway, the same unaltered priority rights still apply in full. Consequently, one of the very first Intellectual Property treaties still forms the foundations of international patent protection to this day.



One chance and one chance only

You only have one chance to file an initial application. It has to be as clear and as detailed as possible the first time around. There are no second chances for making changes to an initial filing. You need to be aware that your commercial success could very much depend on this initial application, and that very strict conditions apply to valid invocation of any priority rights stemming from that initial application.

Making the right choices

In everyday practice, we frequently find that inventors inadvertently and unconsciously have insufficient insight into these procedures and conditions. This publication is intended to provide you with a number of do's and don'ts regarding the initial application, and about the priority right created as a result. This should prepare you sufficiently so, that you can sit down with our specialists and make the

right choices for protecting your Intellectual Property, and optimal use of your priority rights.



Martijn Vermeulen
Partner at EP&C

Priority right gives international priority

Paris Convention virtually unchanged for over a century

In the second half of the nineteenth century, new materials, processes and technical insights caused widespread industrialisation. Factories emerged and stage coaches found themselves competing with faster modes of transport such as the train and the steamer. The world as it was then had started to shrink as technology became smarter and prosperity grew.

It was during this period that a need to coordinate the protection of industrial property internationally, became apparent. Eleven countries signed the Paris Convention in 1883, the first-ever Intellectual Property treaty. Since then, 176 countries have signed.

One of the most important provisions laid down in the Paris Convention is the priority right. Anyone filing an initial application for a patent for an invention, has the right to file the application in other countries that are party to the convention for a period of a year. By invoking this priority right when filing the follow-up applications, the assessment date for patentability is automatically set to the date on which the initial application was filed.

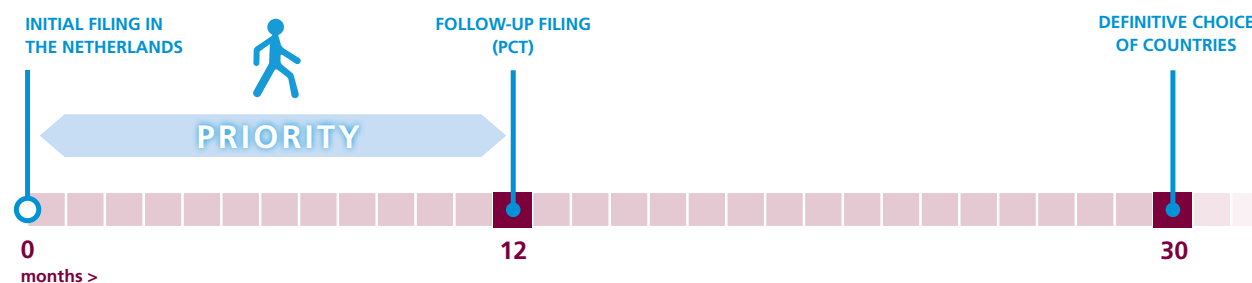
Despite considerable reductions in travelling times since the days of the stage coach, and the short amount of time it takes to send something by digital post, the priority right of the nineteenth century continues to apply to this very day. It also applies to other IP-rights such as trademarks and designs as well.

Why invoke priority?

The most important advantage of invoking priority when filing a follow-up application, is that the date on which the initial application was filed, is automatically adopted as the assessment date for patentability. This means that public disclosures of similar inventions will not be taken into account if these are filed after the date on which you filed your initial application. This means that from

that date onwards, you can exclude more or less all other technology as if your initial application had put the world of technological development on hold. This also applies to your own public disclosure of the invention, which allows you to postpone the costs, which is nice, and it gives you time to consider in which countries you would like to file a patent for your invention. It gives you time to explore the market, find local partners, and so on.

It is important to note that the priority right only applies to what was actually described in your initial application. The twelve month priority right period applies for patents and breeders' certificates. In the case of trademarks and designs the period is six months.



Industrially applicable, novel and inventive

In Europe, a technological invention has to comply with three conditions in order to be considered for patenting.

- Firstly, the product or process has to be new. It must not have been disclosed publicly anywhere in the world prior to the date on which the patent application was filed. This also applies to public disclosure by the inventor in a company brochure, at an exhibition, during a presentation or as information on a website for example.
- Secondly, the invention must be novel, i.e. not obvious to a skilled person.
- The third condition is that the invention has an industrial application.

Extending the effective patent term

The maximum term of a patent is twenty years from the date on which you filed the patent application. If you file a follow-up application exactly one year after you filed a priority application, then the total term of protection is 21 years from the date on which the priority application was filed. If you make use of the priority term, then you can extend the effective patent term of your invention by a year.

Additions to an application can be risky

Adding text to an application that claims a right to priority, after the initial priority application has been filed, can be risky.

If you decide to file a follow-up application invoking the right of priority of your first patent application, and you have made improvements to your invention in the meantime, you may be very tempted to add these improvements to your follow-up application. However, you need to be careful that the initial priority rights still apply.

When you invoke the right of priority for your follow-up application, the assessment date for patentability of that follow-up application will be the same as the date on which the initial patent application was filed.

Assessment date of the invention

It is possible, that an addition or change to a claim* in the follow-up application relative to the initial application, will cause the claim to lose the right of priority. The assessment date for the patentability of this claim then becomes the filing date of the follow-up application and not the filing date of the initial application. This means that every public disclosure made in the period between the date of the very first application and the filing date of the follow-up application will be taken into consideration for the assessment of the patentability of the claim. This may seriously jeopardise your chances of obtaining a patent, for example if you disclosed the invention during that period.

How to structure a patent application

There are no international rules that dictate exactly what information a patent and a patent application must contain. Nevertheless, they often have a standard structure and layout. The patent document contains a text describing the invention. This text starts with a brief description of the prior state of the technology and its disadvantages. This is followed by a description of the invention and an explanation of how it overcomes the disadvantages of the prior state of the technology. After this, there is a description of the one or more designs of the invention, together with an explanation of the implementation of the invention in everyday practice. Reference is often made here to drawings that appear at the beginning or the end of the patent document.

This is followed by the *claims. These are legal and/or technical in nature and summarise the crucial features of the invention. More often than not, they also explain how the invention distinguishes itself from other products, technologies or methods. The patent document is accompanied by an abstract, which contains a brief summary of the invention. This abstract is in addition to, and not part of, the actual patent document.



Patent lost due to changes in application

This case study illustrates the tremendous impact a well-intended change made to a patent during the priority year can have.

A Dutch company filed a priority application in the Netherlands for an invention involving an important improvement to the speed and accuracy of its systems. After filing the Dutch priority application, the company announced the development with due pride in the trade press. At the end of the priority year, they filed a European patent application invoking the priority right of the earlier Dutch patent application. A European patent was subsequently granted for this invention.

The chance to modify

However, when filing in Europe, the company took the opportunity to make changes to the claims in the follow-up application. This is a risky thing to do when it comes to assessing what you actually want to patent. In this company's case, they added modifications to the main claim in the European patent application which were not mentioned in the initial patent application. As a result, the priority right for the main claim was lost and the effective assessment date of the main claim was moved to the (later) filing date of the European application.

The consequence

The articles that the company had published prior to this revised assessment date described

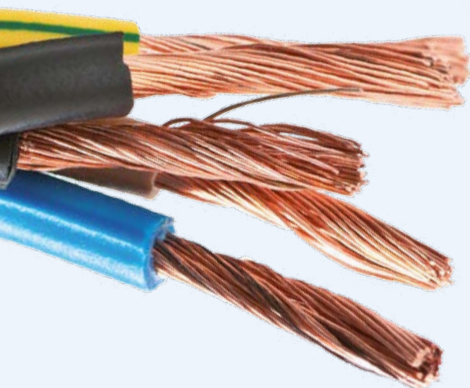
most of the elements of the new main claim but not all of them. Therefore the publications where not novelty destroying for the new claim. Unfortunately, the opposition division of the European Patent Office arrived at the conclusion that the main claim of the patent was not patentable due to lack of inventive step. The differences between the system according to the main claim and the system according to the published articles were deemed obvious on the basis of prior art. This meant that the European patent was no longer inventive due to the company's own public disclosure and the patent was revoked.

Good, accurate and complete

This situation could potentially have been avoided if the additional elements had been included when the initial patent application was first filed, or by refraining from making any additions to the main claim during the European granting procedure.

This case underlines how important it is to ensure that your initial application is accurate and complete. The priority right system was never intended to offer applicants an opportunity to review or add to the content of their follow-up applications. Nowadays, any changes are closely scrutinised and there is little margin for error.

The relevance of genus and species



Copper conducts electricity, but not all electrical conductors are made from copper. This example illustrates the relevance of the principles of genus and species to patent applications.

Let us suppose that your initial patent application for an invention refers to a part that is made from copper (species), because copper conducts electricity. You subsequently come up with the idea that the invention can also be made from other conductive materials, and that protection for these other conductive materials would be advisable. In your follow-up application, you therefore include the claim that the part in question must be made from a material that conducts electricity (genus). However, no mention was made of conductive materials in the initial application, and there is therefore no priority right to invoke for this broader feature, even though it might seem logical from the context of the text of the initial patent application. After all, you chose copper in the initial application phase because it conducts electricity.

The consequence here, is that the assessment date of the claim which mentions materials that conduct electricity instead of just copper, will not be the filing date of the initial application but that of the follow-up application itself.

Prejudicial to novelty

If you have disclosed your invention in which copper is applied publicly, in the period between filing the initial patent application and filing the follow-up application, this public disclosure will be prejudicial to novelty for every

patent application in respect of this invention following this public disclosure. The public disclosure is also prejudicial to novelty for a claim that seeks broader protection, such as the claim broadly mentioning conductive materials. After all, an embodiment, copper, which falls within the new broad definition has been publicly disclosed. The assessment date for the broadened claim mentioning the conductive materials featured in this example is the filing date for the follow-up application, and because of this, a patent will not be granted for this broad claim.

Generalisation

You could limit the scope of protection of the patent to the claim with the copper part, as this is already a valid priority claim. However, by doing so, you potentially pave the way for others to copy the invention using a different conductive material.

When drafting an initial patent application it is therefore always better to think about the alternatives and the generalisation of features of the invention, and to include these in the very first patent application. Your patent attorney will do this for you to this best of his ability, but you can always assist him in this, as ultimately, you are the one with the specific technical knowledge of your invention.

Even genuine mistakes are difficult to rectify

Mistakes can creep into a patent application. Yet even the most genuine of mistakes can only be rectified on the condition that it is obviously and unequivocally clear, that nothing else could be intended other than what is being offered as the correction. If this condition is not met, the mistake or inaccuracy in the patent application may not be rectified. This can have some nasty consequences.

A European patent application by Myriad is a good example. In its priority application a sequence* with 1863 amino acids is described. This sequence was publicly disclosed after the priority application was filed, but before they filed the European patent application. It subsequently transpired that the sequence contained 9 incorrect amino acids, which meant that the European follow-up application invoking priority of the priority application needed to be amended. The correct sequence was added and the patent was granted.

During opposition procedures, the Opposition Division subsequently decided that the claim in the European patent application containing the correct sequence had no right to priority because the sequence was not the same as the one in the priority application. The corrections were not obviously and unequivocally clear. Moreover, the corrected sequence was not considered inventive in comparison with the incorrect sequence that had already been publicly disclosed, and was therefore no longer patentable.



“Unless the conditions are met, a mistake in the patent application cannot be rectified.”

* The sequence refers to the order of nucleotides in a DNA or RNA molecule, or the order of amino acids in a protein.

A grace period is the exception

Publicity prior to filing a patent application is not always damaging for patentability. In some countries, the United States, Canada and Australia for example, there is something called a grace period. This means that, under certain circumstances, you reserve the right to patent your invention during a period of twelve months after its first disclosure

Thanks to this grace period, protecting an invention is not, by definition, doomed to failure across the globe, even once it has entered the public domain. This is at odds with the European system, which stipulates that a patent will not be granted for an invention that has already been publicly disclosed. When it comes to the protection of Intellectual Property on an international level, this grace period system causes misunderstandings and serious blunders.

Take Apple for example. Back in 2007, the company presented its new iPhone, with a great deal of pride, and presented its latest invention in the operating system in a video. This well-known iPhone presentation is still available on YouTube.

After releasing the video, the company applied for a patent in America. Then it filed a patent application in Europe, invoking priority. The company fell flat on its face when its application was rejected. The invention had been publicised prior to the priority date on the American patent, and even though the American patent was still valid, the company's competitors were free to hijack the invention in Europe.

Now, talks are being held internationally in an effort to harmonise the grace period worldwide.



Trademarks have priority right for six months

The priority right on a patent is valid for twelve months, whereas for trademarks, it only lasts for six. This six-month period is a good time for deciding whether or not you want to register your trademark in other countries.

Generally speaking, six months is more than enough time to complete the registration process in the Benelux. Then, based on the outcome of the registration process, you are in a position to decide whether or not you want to register the trademark in other countries. Should your trademark be rejected in the Benelux for instance, it is highly unlikely

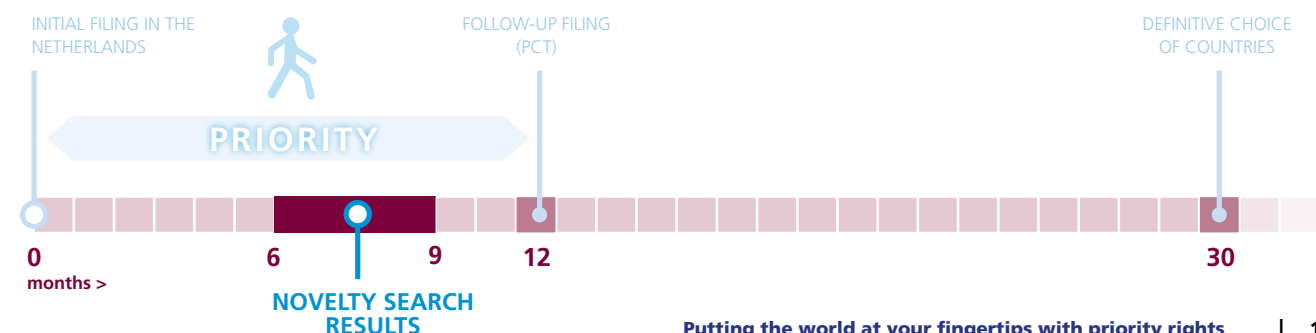
that you will want to register it in other countries. Therefore saving you a great deal of money. If you invoke your priority right when registering in other countries, you will be able to prevent other parties from registering a similar trademark. This only applies if the other party files its application in the six-month period after you file yours.

The chances of obtaining a patent

You can find out the chances of obtaining a patent for your invention from the European Patent Office. The best time to do this is in the priority year.

The priority year is generally the ideal time for calculating the chances of obtaining a patent for your invention. It is also a good idea to conduct an exploratory literature study before you start drafting your patent application. This is an effective means of defining the claims accurately and with the correct information. The actual chances of you obtaining a patent can be attained from the European Patent Office (EPO). The EPO carries out a novelty search to establish whether or not your invention is eligible for patent protection. The results are then released around six to nine months after you file your initial application.

When filing an initial application in the Netherlands, we recommend that you apply for an international novelty search. In this report, an examiner from the European Patent Office issues an opinion on the patentability of the invention described in your patent application. This information is useful at the end of the priority term when you come to deciding whether or not you want to file patent applications in other countries. You should also consider the need for additional information which will help you make such a decision, like a commercial feasibility study, for example, which is worth commencing once you have filed your initial application.



European grace period for designs

Technological inventions can be protected by patents, whereas the design (or look) of a product can be protected using design rights.

When it comes to patent protection in the Netherlands and Europe, the rules on public disclosure are unremitting. Yet there are a couple of exceptions with grace periods applying in a number of countries, and different rules that apply to designs. In Europe, anyone wanting to apply for design right protection can do so up to one year after their design entered the public domain.

Pay careful attention to dates on internet publications

Filing a patent application establishes a priority right, which means you are at liberty to publish information regarding your invention. However, if you publish information on the Internet using electronic documentation in Word or PDF format for example, it is always a good idea to check the date in the document and the date it was created.

The reason for being extra careful here, is the fact that the examiners of the European Patent Office increasingly consult the Internet in addition to their enormous database of previous patent publications. Your own website is also included in their search.

If you have published a document on your website for example, that appears to have been created prior to the filing date of your initial patent application, the European Patent Office examiner could, in certain cases, argue that the date on which it was created counts as the publication date. This will result in the rejection of your patent application. It is then up to you to prove that the electronic document was not published on the Internet until after you filed your application.

It is therefore advisable to pay close attention to dates in or on any documents and photos you publish on your own website or on the Internet, as this could save you a great deal of time, money and red tape.



Registration at civil-law notary does not offer protection at a later stage

The registration of a technological invention with a civil-law notary or the Tax and Customs Administration, or the filing of an Idepot with the Benelux Trademarks Office, is a relatively cheap and simple option. However, from a legal point of view, this does not offer any basis for protection.

It cannot be used for invoking priority and this registration has no value when it comes to obtaining a patent. Saying this, as long as the registration remains secret, it does not stand in the way of you obtaining a patent later.

Neither can a third party use this registration to oppose the validity of an eventual patent application, because the registration is not a public one.

Registration with a civil-law notary or the Tax and Customs Administration can however be used to demonstrate that you had certain knowledge or a particular idea on a particular date. This can, for example, be used in the unlikely event of legal proceedings concerning ownership of the knowledge or the idea. This may make this form of registration a good shield, but an ineffective sword.

Double protection requires coordination

Applying for a patent for a technological invention whilst also registering the appearance of a product based on that invention as a design, could be a very useful strategy. However, this kind of double protection does require careful coordination.

In Europe, registering a design is very quick and easy, and it is cheap compared with applying for a patent. In fact, anyone registering a design on a Monday can count on it being published that same week. In some cases, this may be a little too fast!

If your design is published before you have filed your patent application, it could seriously stand in the way of your patent being granted. A solution to this is opting for postponed publication when you register your design. This means you can be certain that the design will not be published until after your patent application has been filed. As you can imagine, optimal coordination of these two processes can make a vital difference here.

Protection is a balancing act

Protecting an invention with a patent is a balancing act between keeping your ideas secret, and knowing when it is safe to make them known to the public. Whilst an inventor can hardly wait to tell others about his/her achievements, a successful route to patenting calls for restraint.

The point in time you choose to file your application is therefore crucial, and calls for careful consideration. Is the invention ready for patenting, and how far are your competitors with their similar inventions?

No second chances

Often, there are several companies in the same sector working concurrently, yet independently of one another, on a solution to the very same technical problem. It is vitally important therefore, to be the first to apply for protection for the invention that will provide the solution. Meanwhile, by the time you come to filing a patent application, you need to know exactly how to construct your invention and be able to provide a full and accurate description.

When drafting the patent application, you need to uncover every publication that relates to the invention, worldwide. Moreover, the patent application has to be right first time, as there are rarely second chances. This process calls for essential professional assistance and realistic advice from a patent attorney, one who will work closely with the inventor and help you find the right balance.



Colophon

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